

REMARKS

Upon entry of the Amendment, Claims 1-17 will be pending in the application.

New Claim 17 is added. Support may be found, for example, at page 17, lines 1-6 of the specification as originally filed. No new matter is added.

Entry of the Amendment is respectfully requested along with reconsideration and review of the claims on the merits.

Formal Matter

Applicants appreciate that the Examiner has acknowledged the claim for foreign priority and the receipt of the priority documents.

Response to the Claim Rejection Under 35 U.S.C. § 103

Claims 1-16 are rejected under 35 U.S.C. §103(a) as assertedly being unpatentable over Ito et al. (European Patent No. EP 950922 A1) in view of Kondo (U.S. Patent No. 6,080,535).

The Examiner cites Ito et al. as disclosing a silver halide color photographic material having improved sharpness and color reproducibility, said material containing a coupler according to the present invention. The Examiner cites Ito as teaching that known silver halide emulsions are generally disclosed on pages 65-66, with no particular preference noted therein.

The Examiner cites Kondo as disclosing a silver halide emulsion having enhanced sensitivity without increasing fog, said emulsion comprising tabular silver halide grains wherein at least 50% of the total grain projected area is accounted for by grains having an aspect ratio greater than 5 and containing silver iodide, wherein the grains meet the relationship $I_2/I_1 < 1$.

The Examiner asserts that it would have been obvious to one of ordinary skill in the art to incorporate the silver halide emulsion taught in Kondo into at least one silver halide emulsion layer of the photographic material of Ito et al., with reasonable expectations of achieving, absent object evidence to the contrary, the advantages taught therein as well as those achieved with the use of the emulsion.

Applicants respectfully traverse the Examiner's *prima facie* obviousness rejection because the combination of Ito with Kondo fails to render obvious the present invention.

Ito et al. does not disclose the present invention, and furthermore the present invention recited in claims 1 to 16 are not *prima facie* obvious over a combination of Ito et al. and Kondo.

More specifically, each of formulae (I) and (II) of the present invention and formula (I-3c) of Ito et al. can be distinguished from each other in terms of the groups $C(R_4)(R_5)INH$ and $(R_3)_m$ bonded to a phenyl group of a phenyloxycarbonylamino in formulae (I) and (II) of the present invention. In the present invention, R_3 is an essential group and it defines a Hammett substituent constant σ_p . In contrast, the exemplified compounds pointed out by the Examiner in Ito, other than compound 27, do not satisfy the conditions for $(R_3)_m$ and/or INH of the present invention. Further, in terms of form, although compound 27 is included in formula (I) of the present invention, Ito et al. does not disclose or even suggest a technical concept that specifies the structure of the compounds expressed by formula (I). Therefore, Applicants submit that it is reasonable to conclude that the structure of compound 27 is only incidentally included in formula (I) of the present invention, and therefore it is not appropriate to conclude that formulae (I) and

(II) of the present invention are covered by Ito et al. and disclosed by Ito, merely by the presence of compound 27.

For the reasons described above, Applicants submit that the present invention is not *prima facie* obvious from the combination of Ito et al. and Kondo.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a), and earnestly request allowance of Claims 1-16.

Furthermore, Applicants previously noted new Claim 17. Applicants submit that compound 27 from Ito et al. does not fall within the scope of new Claim 17. Accordingly, Applicants respectfully request consideration and allowance of Claim 17.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. PATENT NO. 10/689,356

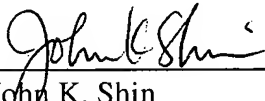
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER



John K. Shin
Registration No. 48,409

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